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a barrel forming an axial fluid pathway therethrough, said barrel having a top end and a bottom end, said barrel forming a lower outwardly tapered section having at least one substantially planar section;
at least one slip movably connected to said substantially planar section of said tapered section for selectively engaging an interior portion of a tubular member;
a moving mechanism functionally connected between said slips and said barrel for moving said slips in engaging contact with and from said tubular member; and,
a sealing element in connection with said barrel for sealing the annulus between said tool and the interior surface of said tubular.--.

REMARKS

REJECTIONS UNDER 35 U.S.C. 102:

Claims 1, 4, 6, and 11 stand rejected under 35 USC 102(b) as being anticipated by Burner, U.S. Pat. No.3,265,431. Applicant believes the claims as amended are patentably distinct over Burner. The Examiner stated in the Office Action that Claim 5 would be patentable if rewritten in independent form. Accordingly, Applicant has amended Claim 1 to add the limitations of Claim 5 in Claim 1. Further Claims 4, 6 and 11 depend from Claim 1. Therefore, Burner does not claim nor disclose a tubular running tool as claimed in Claim 1 or its dependent claims. Applicant respectfully requests reconsideration of the rejection in light of the amendments.

Claims 1-4, 6, 10, 11, 15, 16, 18, 19, 24 and 25 stand rejected under 35 USC 102(b) as being anticipated by Denny, U.S. Pat. No.4,235,469. Applicant believes the claims as amended are

patentably distinct over Denny. Claim 1 and its dependent Claims; 2-4, 10, 11 are believed patentable for the same reasons as given above. Further, Applicant has amended Claim 15 to add the limitations of Claim 5. Therefore, Claim 15 and its dependent Claims; 16, 18 and 19, are believed patentable over Denny. As well, Applicant has amended Claim 24 to add the limitations of Claim 5. Therefore, Claim 15 and its dependent Claim 25 is believed patentable over Denny. Denny does not claim nor disclose a tubular running tool as claimed in Claims 1, 15 or 24 or the claims depending therefrom. Applicant respectfully requests reconsideration of the rejection in light of the amendments.

Claims 1-4, 6, 10, 11, 15, 16, 18, 19, 24 and 25 stand rejected under 35 USC 102(b) as being anticipated by Guess, U.S. Pat. No.1,445,680. Because Applicant has included the limitations of Claim 5 in the independent claims, Applicant believes the claims as amended and all claims depending therefrom are patentably distinct over Guess for the same reasons as given above. Guess does not claim nor disclose a tubular running tool as claimed in Claims 1, 15 or 24. Applicant respectfully requests reconsideration of the rejection in light of the amendments.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. 103:

Claims 7-9, 13, 14, 21-23 and 26-28 stand rejected under 35 USC 103(a) as being unpatentable over Guess, U.S. Pat. No.1,445,680, in view of Hawkins, US Pat No. 5,735,348. Applicant requests reconsideration of the rejection. Further, the combination of Guess and Hawkins does not render obvious Applicant's invention.

Guess discloses a spear. The operation of the spear is to let the spear down to a point below the casing to be removed and then jerking the spear upwards to cause the slips to spread out and

drive the four tripping members into contact with the casing.

The present invention is a tubular running tool and not a spear. The present invention allows the internal gripping of tubulars and pumping of fluid into the tubulars as a tubular string is being lowered down-hole.

Further, the Applicant is very familiar with the Hawkins patent since it and the present invention are commonly owned.

Applicant requests reconsideration of the three basic criteria to establish a case of prima facie case of obviousness because applicant believes the claims are not obvious.

Examiner has stated that the level of skill in the art renders Applicant's invention obvious. Specifically, Examiner stated that it would have been obvious to one of ordinary skill in the art to combine the references. However, Applicant's claims as amended are not disclosed by Guess and Hawkins, in that a combination of Guess and Hawkins is not each and every element of Applicant's invention as discussed above. Therefore, Applicant respectfully requests reconsideration of the rejection in light of the amendments.

Additionally, the analysis requires two further steps. The second step is that there must be a reasonable probability of success. There is no probability of success because Applicant's invention is not disclosed by the combination of Guess and Hawkins.

The last criterion is that the prior art references must teach all the claim limitations. **MPEP 706.02(j)**. Further, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based upon the applicant's disclosure." **Id, See In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991)**.

There is no suggestion of success in combining the references cited. Accordingly, Applicant

respectfully requests reconsideration of the rejection.

In application of all three criterion, the cited prior art references fail to establish a prima facie case of obviousness. All the elements of Applicant's invention are not disclosed in Guess and Hawkins, III. Further, there is no suggestion in the independent references to combine the teachings. Nor is there any indication that the combination would be a success. Therefore, applicant requests that the rejection be removed in conformity with the case law. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Further, case law dictates removal of the rejection. The cases *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992) and *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1991) support the proposition that knowledge generally available to one of ordinary skill in the art may not be used to maintain a rejection under 35 U.S.C. 103(a). In fact, both cases reversed the Patent Office and the Board of Patent Appeals rejection of the respective claims based upon the knowledge generally available to one of ordinary skill in the art. *In re Jones*, 958 F.2d at 351, *In re Fine*, 837 F.2d at 1075. The "teachings of references can be combined only if there is some suggestion or incentive to do so." *In re Fine*, 837 F.2d at 1075. (The Federal Circuit reversed the rejection because the cited prior art references contained no suggestion to combine). Therefore, the knowledge of those of ordinary skill in the art may not be used to combine references without some suggestion in the cited prior art references themselves, especially when all the claim elements are not disclosed.

To point, "[a] statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill in the art at the time the invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective

reason to combine the teachings of the references.” MPEP 2143.01, *See Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). Therefore, the mere fact that the cited prior art references may be modified to obtain the Applicant’s invention is not sufficient reason to reject the application under 35 U.S.C. 103(a) without some suggestion in the prior art references for the combination. Accordingly, because the cited prior art references contain no suggestion to modify or combine the references to arrive at Applicant’s invention, the rejection should be removed. *See Ex parte Levengood*, *See In re Vaeck*, *See In re Fine*, *See In re Jones*. Accordingly, applicant respectfully requests reconsideration in light of the amendments.

Applicant believes the claims as amended are not rendered obvious by the combination. Accordingly, Applicant respectfully requests the Examiner to reconsider the rejection in view of the amendments.

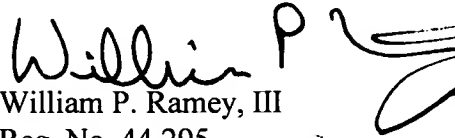
NEW CLAIMS

Applicant has added new Claims 33, 34, 35 and 36. These Claims are combinations of claims rejected under 35 U.S. 103 written in independent form. These rewritten claims are patentably distinct over the prior art. As stated above, the combination of Guess, U.S. Pat. No. 1,445,680 and Hawkins, U.S. Pat. No. 5,735,348, do not disclose each and every element of Applicant’s invention. Guess does not disclose a tubular running tool and there is no suggestion to combine the fill-up and circulation tool of Hawkins. Accordingly, Applicant requests further consideration of these rewritten claims.

CONCLUSION

Applicant extends thanks for the Examiner's kindness and suggestions. Further, Applicant believes the application is now patentable over the cited references and that all objections and rejections have been cured.

Sincerely,
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